REMARKS

An Office Action was mailed in the instant case March 17, 2005, wherein Claims 1-18 as originally filed were rejected.

Applicant submitted a response to this Office Action in the form of an amendment under 37 CFR 1.111 on August 15, 2005.

In a Notice of Non-compliant Amendment dated August 25, 2005, Applicants' response of August 15, 2005 was held non-compliant for clerical errors.

On September 13, 2005, Applicant submitted a response to the Notice of Non-compliant Amendment mailed August 25, 2005 correcting the clerical errors identified by the Examiner.

In an Office Action date December 5, the Examiner held the amendments made in the September 13, 2005 response to be non-responsive as being drawn to a non-elected invention.

On January 5, 2006 Applicant filed request for continued examination and filed two submissions under 37 CFR § 1.114, an amendment and an information disclosure statement.

On January 13, 2006, the USPTO mailed a Notice of Improper Request for Continued Examination indicating that prosecution was not closed, therefore an RCE was not proper. Further the notice indicated that the submission under 1.114 would be entered as a response to the office action of December 5, 2005.

THEREFORE, this paper is a supplemental response to the reply mailed January 5, 2005 as an answer to the notice of December 5, 2005. Applicant respectfully petitions for a one month extension of time, if necessary. The commissioner is authorized to debit the required amount from deposit account 05-1712. Applicant also requests a refund of the RCE fee paid on January 5, 2006.

Applicant will respond to the various Office mailings in reverse chronological order.

Response to Notice of Improper Request for Continued Examination dated January 13, 2006.

A copy of the Notice of Improper Request for Continued Examination dated January 13, 2006 is attached hereto. Applicant has submitted this supplemental response to address all outstanding issues in prosecution and thus withdraws the Request for Continued Examination.

Response to Office Action dated December 5, 2005.

In the Office Action dated December 5, the Examiner held the amendments made in the September 13, 2005 response to be non-responsive as being drawn to a non-elected invention. Specifically the Examiner stated that " [t]he amendment filed on 9-13-2005 canceling all claims drawn to the elected invention and presenting only claims drawn to a non-elected invention [was] non-responsive...[because]... all of the claims are now directed to a resin particle with a specified structure (size) that was never presented before for examination." Applicant respectfully disagrees. First, Applicant has not cancelled any claim in the instant application. Second, there is not now nor has there ever been any restriction requirement in the instant application. Third, the Examiner alleges the resin particle and its size have never been presented for examination before. This is not correct. Claim 15 as originally filed was directed to an expanded olefin resin particle comprising the expanded olefin resin of claim 1. Thus the idea that the resin in claim 1 could be in particle form was clearly in the claims from the beginning and thus was searched and examined already by BOTH examiners, e.g. Examiner Foleak who allowed the claims initially, and the instant Examiner. Furthermore, the idea that a particle might have a specific size is clearly within the scope of the original claims (specifically claim 15) as filed and examined by both Examiners.

The Examiner cites MPEP § 821.03 in support of the above position. MPEP § 821.03 states that claims added by amendment following an action by the examiner to an invention other than previously claimed...[will be restricted to the previously claimed

invention]...." Applicant notes that this is not the case here. Applicant's claim to a particle of the resin was presented in claim 15 as field and examined. Thus Applicant has not presented claims to an invention that was not previously claimed. MPEP § 821.03 is not applicable in the instant case.

Furthermore, Applicant has additionally limited the claims to particles of a specific size. This is even more narrow than the invention presented in claim 15.

Applicant respectfully requests that the Examiner withdraw this newly imposed "restriction" requirement under MPEP § 821.03.

Response to Notice of Non-compliant Amendment dated August 25, 2005.

In the Notice of Non-compliant Amendment, Applicant's response of August 15, 2005 was held non-compliant for a single clerical error in claim 16. On September 13, 2005, Applicant submitted a response to the Notice of Non-compliant Amendment mailed August 25, 2005 correcting the clerical error identified by the Examiner.

Response to the Office Action dated March 17, 2005

Claims 1-18 as originally filed were rejected in an Office Action dated March 17, 2005. There was no restriction requirement in this office action. Applicant submitted a response to this Office Action on August 15, 2005.

For the Examiner's convenience, Applicant repeats remarks relating to the originally rejected claims.

Summary:

Claims 1-18 have been amended.

No claims have been canceled.

No New Claims have been added.

Claims 1-18 remain in the present application.

Applicants have amended Claim 1, and the claims that depend therefrom to further clarify that Applicants' presently claimed invention recites an expanded olefin resin particle, the particle having a particle size capable of passing through a number 2.5 Tyler mesh sieve, but which is retained on a number 30 Tyler mesh sieve. Support for this amendment is found at claim 15 and page 23, paragraph [0074]. Claim 15 has also been amended to further clarify a preferred embodiment of the presently claimed invention comprises spherical particles. Support for this amendment is found in numbered paragraph [0074] of the application as filed. Previously independent Claims 16 and 17 have been amended to depend from independent Claim 1.

Double Patenting

In the Office Action dated March 17, 2005, Claims 1, 3-4, and 17 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 13 of U.S. Patent number 6,809,168 to Agarwal et al. (hereinafter Agarwal-168.)

Claim 1, and the claims that depend therefrom, have been amended to further clarify that Applicant's presently claimed invention recites an expanded olefin resin particle having a particle size capable of passing through a number 2.5 Tyler mesh sieve, but which is retained on a number 30 Tyler mesh sieve. Claim 13 of Agarwal-168 recites an article comprising a skin layer...wherein the skin layer is present on a film, fiber, fabric, molded article, and/or foamed article. Claims 13 does not recite nor suggest an expanded olefin resin particle and thus, Claim 13 of Agarwal-168 does not render Applicant's presently claimed invention obvious. As such, a rejection based on obviousness-type double patenting is inappropriate. In light of the amendments made to the claims, removal of the rejection is respectfully requested.

Claim Rejections Under 35 USC §102

In the Office Action dated March 17, 2005, Claims 1-13, and 15-18 were rejected under 35 USC §102 (e) as being anticipated by U.S. Patent number 6,809,168 to Agarwal et al (hereinafter Agarwal-168.)

In the Office Action dated March 17, 2005, Claims 1-11, 15, and 17 were rejected under 35 USC §102 (b) as being anticipated by U.S. Patent application US 2002/0013440 to Agarwal et al. (hereinafter Agarwal-440.)

To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1007 (1988).

The test for anticipation is symmetrical to the test for infringement and has been stated as: "[t]hat which would literally infringe [a claim] if later in time anticipates if earlier than the date of invention.@ *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *Connell v. Sears Roebuck & Co.*, 722 F.2d 1542, 1548, 220 U.S.P.Q. 1931, 1938 (Fed. Cir. 1983).

Moreover, the single source must disclose all of the claimed elements arranged as in the claim.@ *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984). Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 780, 227 U.S.P.Q. 773, 777 (Fed. Cir. 1985).

Applicant has amended Claims 1-18 as discussed above to further clarify that Applicant's presently claimed invention recites an expanded olefin resin particle, expanded with a blowing agent, and having a particle size capable of passing through a number 2.5 Tyler mesh sieve, but which is retained on a number 30 Tyler mesh sieve.

However, Argarwal-168 and Argarwal-440 provide portions of identical disclosure directed to articles formed from propylene diene copolymers. At Col. 27, line 59 to Col. 29, line 26, Argarwal-168 discloses producing flat foamed sheets (Col. 28, line 30.) The portion of the disclosure of Agarwal-440 directed to foamed articles begins at numbered paragraph [0190], and is identical to the above referenced disclosure of Agarwal-168. Argarwal-440 is also identical to Agarwal-168 in that both references disclose producing flat foamed sheets (numbered paragraph [0192] of Agarwal-440), but fail to disclose or suggest the formation of Applicants recited expanded olefin resin particle.

Argarwal-168 and Argarwal-440 thus fail to disclose or suggest all of Applicant's recited limitations. Accordingly, neither Argarwal-168 nor Argarwal-440 can reasonably be found to anticipate Applicant's presently claimed invention.

Claim Rejections Under 35 USC §103

In the Office Action dated March 17, 2005, Claims 1-11, 15, and 17 were rejected under §102 (b) as being anticipated by or, in the alternative, under §103(a) as being obvious over US 2002/0013440 to Agarwal et al. (hereinafter Agarwal-440.) Claims 10 and 11 have been rejected under §102 (e) as being anticipated by or, in the alternative, under §103(a) as being obvious over Agarwal-168.

As discussed above, neither Agarwal-168 nor Agarwal-440 can reasonably be found to anticipate Applicant's presently claimed invention. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. To do so, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Agarwal-440 is directed to propylene diene copolymers. In numbered paragraph [0086], Agarwal-440 discloses foamed articles to be another useful application of the disclosed copolymers. The disclosure of Agarwal-440 directed to foamed articles begins at numbered paragraph [0190], and is identical to the above referenced disclosure of Agarwal-168. Argarwal-440 is also identical to Agarwal-168 in that the reference discloses producing flat foamed sheets (numbered paragraph [0192]), but fails to disclose or suggest the formation of Applicant's recited expanded olefin resin particle.

Applicant has amended Claims 1-18 as discussed above to further clarify that Applicant's presently claimed invention recites an expanded olefin resin particle expanded with a blowing agent, and having a particle size capable of passing through a number 2.5 Tyler mesh sieve, but which is retained on a number 30 Tyler mesh sieve. Applicant also notes in numbered paragraph [0009] of the instant application, expanded resin beads may demonstrate undesirable characteristics, which may be inconsistent with a materials use. Thus the ability to produce an expanded olefin resin particle does not automatically flow from the ability to produce a foamed article from a particular resin. Identical to Argarwal-168, Argarwal-440 discloses direct formation of a foamed sheet from an olefin resin and a blowing agent, however, the references fail to disclose or suggest discrete olefin resin particles or a process for making them. Argarwal-440 also fails to disclose or suggest expanded olefin resin particle having a particle size capable of passing through a number 2.5 Tyler mesh sieve, but which is retained on a number 30 Tyler mesh sieve. As such, Argarwal-440 does not disclose all of Applicant's recited limitations, nor provide a teaching or suggestion of success directed to expanded olefin resin particles as recited by Applicant. Accordingly, Argarwal-440 cannot reasonably be found to render obvious Applicant's presently claimed invention.

In the Office Action dated March 17, 2005, Claims 12-14, 16 and 18 were rejected under §103(a) as being unpatentable over Agarwal-440 in combination with Polymer Technology Dictionary (hereinafter Dictionary.) Claim 14 has been rejected under §103(a) as being unpatentable over Agarwal-168 in combination with Dictionary.

Dictionary discloses certain blowing agents. Dictionary does not disclose, nor suggest Applicants recited expanded olefin resin particle having a particle size capable of passing through a number 2.5 Tyler mesh sieve, but which is retained on a number 30 Tyler mesh sieve. Dictionary thus fails to remedy the deficiencies in either Agarwal-168 or Agarwal-440. Accordingly, Claims 12-14, 16 and 18, as amended, are not rendered obvious by the combination of the cited references.

A Supplemental Information Disclosure Statement and Form 1449 were filed on January 5, 2006. Applicant respectfully requests that the Examiner consider the

references submitted therein. If there are any additional charges with respect to the Amendment or otherwise, please charge them to Deposit Account No. 05-1612 maintained by Assignee.

Applicant respectfully requests the rejection of the claims be removed, and the claims be passed to allowance. Reconsideration and allowance is respectfully requested.

Respectfully submitted,

Jan 26, 2006
Date:

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Please find below and/or attached an Office communication concerning this application or proceeding.

ACKNOWLEDGED
PATENT LEGAL ASSISTANT GROUP
G. M. CARROLL
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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE

DATE MAILED:

NOTICE OF IMPROPER REQUEST FOR CONTINUED EXAMINATION (RCE)

The request for continued examination (RCE) under 37 CFR 1.114 filed on 1/5/06 is improper for reason(s) indicated below:

☐ 1. Continued examination under 37 CFR 1.114 does not apply to an application for a design patent. Applicant may wish to consider filing a continuing application under 37 CFR 1.53(b) or a CPA under 37 CFR 1.53(d). An RCE cannot be treated as a CPA.

☐ 2. Continued examination under 37 CFR 1.114 does not apply to an application that was filed before June 8, 1995. Applicant may wish to consider filing a continuing application under 37 CFR 1.53(b).

☒ 3. Continued examination under 37 CFR 1.114 does not apply to an application unless prosecution in the application is closed. If the RCE was accompanied by a reply to a non-final Office action, the reply will be entered and considered under 37 CFR 1.111. If the RCE was not accompanied by a reply, the time period set forth in the last Office action continues to run from the mailing date of that action.

☐ 4. The request was not filed before payment of the issue fee, and no petition under 37 CFR 1.313 was granted. If this application has not yet issued as a patent, applicant may wish to consider filing either a petition under 37 CFR 1.313 to withdraw this application from issue, or a continuing application under 37 CFR 1.53(b).

☐ 5. The request was not filed before abandonment of the application. The application was abandoned, or proceedings terminated on _____. Applicant may wish to consider filing a petition under 37 CFR 1.137 to revive this abandoned application.

☐ 6. The request was not accompanied by the fee set forth in 37 CFR 1.17(e) as required by 37 CFR 1.114. Since the application is not under appeal, the time period set forth in the final Office action or notice of allowance continues to run from the mailing date of that action or notice.

☐ 7. The request was not accompanied by a submission as required by 37 CFR 1.114. Since the application is not under appeal, the time period set forth in the final Office action or notice of allowance continues to run from the mailing date of that action or notice.

Note: A continued prosecution application (CPA) under 37 CFR 1.53(d) cannot be filed in a utility or plant application. A CPA filed in a utility or plant application that has a filing date **on or after June 8, 1995** will be treated as an RCE under 37 CFR 1.114. The request for a CPA in the instant application, however, has been treated as an improper RCE for the reason(s) indicated above.

A copy of this notice MUST be returned with any reply.

Direct the reply and any questions concerning this notice to:

Timothy Cole, Technology Center 1700

(571) 272 - 0999
~~(703) 30~~

FORM PTO-2051 (Rev. 7/2003)